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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,458	09/01/2004	Ho Sung Kim	P/3653-10	9993
2352	7590	05/26/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 05/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,458

Applicant(s)

KIM, HO SUNG

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/1/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Both claims 4 and 9 recite "a liquid phase binder". It is not apparent whether the recited binder is the same or different from the liquid phase binder recited in the base claim 1.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over AU Patent Application 200151857 to De Toffol (hereinafter AU De Toffol) or under 35 U.S.C. 102(a and e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over its US corresponding patent 6,476,087 to De Toffol (hereinafter US De Toffol).

Both references disclose a method of manufacturing of syntactic foam including the steps of providing a predetermined ratio of constituent materials including a liquid phase binder and microspheres that are naturally buoyant in that binder; blending the constituent materials into a mixture and placing the mixture into a mould; draining excess liquid phase binder from the mould; and allowing the remaining liquid phase binder to set or cure between the microspheres. See all illustrative examples. The reference further expressly states that in "an especially preferred aspect of the invention, the syntactic foam is made by a method in which the mould is the porous wick for removal of the solvent. The porous wick itself may be made from any material that is capable of soaking up or removing the solvent. The most preferred porous wick is made of plaster. Alternatively, the porous wick may be made of clay, ceramic, cement, concrete, finely perforated plastic or metallic sheets with absorbent backing, fine metallic mesh/gauze with absorbent backing, rigid porous foams or sponge-like material." See, for example, column 2 of the US patent. This disclosure implies that the removal of solvent is done slowly by soaking the excess solvents up with the mold material (which includes removal at least portion of the liquid phase through the bottom of the mold). The slow process of soaking the liquid phase will inherently results in

Art Unit: 1711

microspheres (at least a portion of microspheres) to float to the top of the mixture due to its buoyant nature. Furthermore, by draining all of the excess of liquid phase, it is reasonable believed that the microspheres become inherently closed packed and reach the bottom of the mold. The burden is shifted to the applicant to provide factual evidence to the contrary. Among suitable liquid phase binder and solvents, epoxy resins with hardeners and acetone, respectively, are expressly disclosed by the reference. The invention as claimed, therefore, is fully within the purview of the cited references.

As for the product claimed in claim 9 claimed as a product obtained by a process of claim 1, since the product components and the process disclosed in the references is substantially the same as the claimed process, it is reasonable believed that the product of claim 9 is patentably indistinguishable from the products disclosed in the references. Moreover, even if, *arguendo*, the process disclosed in the reference would have been different from the claimed product, it is reasonable believed that the claimed product is identical to the disclosed product since it is obtained from identical components by draining the excess liquid and allowing the binder to cure. The burden is shifted to the applicant to provide factual evidence that the claimed product is necessarily different and patentably distinct from the product disclosed in the references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ

Irina S. Zemel
Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to read 'Irina Zemel', written in a cursive style.